

27 / Appeal
PATENT
2/20/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: JAU-YUEN SU ET AL.
SERIAL No.: 09/394,918

FILED: September 13, 1999

FOR: PROCESS FOR SAWING SUBSTRATE



GROUP ART UNIT: 3724

EXAMINER: Omar FLORES-SANCHEZ

ATTY. REFERENCE: SUJA3001/WKP

Confirmation No.: 5130

Customer No.: 23364

W. Hart

MAIL STOP APPEAL BRIEF-PATENTS

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The below identified communication(s) or document(s) is(are) submitted in the above application or proceeding:

☒ **RESPONSE TO
NOTIFICATION OF NON-
COMPLIANCE**

- ☐ Issue Fee and Publication Fee Transmittal
☐ Check in the Amount of \$ _____
☐ Application Data Sheet
☐

☒ **APPELLANT'S BRIEF
UNDER C.F.R. § 1.192 (filed
on October 28, 2003 but
resubmitted to place same in
compliance with Notification of
Non-Compliance) with
Appendices (in Triplicate)**

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☒ Please debit or credit **Deposit Account Number 02-0200** for any deficiency or surplus in connection with this communication. A duplicate copy of this sheet is provided for use by the Deposit Account Branch.

☐ Small Entity Status is claimed.

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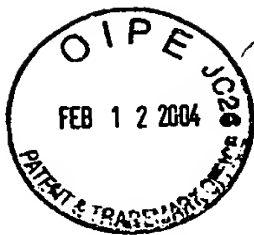
DATE: February 12, 2004

Respectfully submitted,

WONKI K. PARK

Attorney for Applicant

Registration Number: 38,991



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/394,918

Group Art Unit: 3724

Applicant: Jau-Yuen SU

Examiner: Omar FLORES-SANCHEZ

Filed: September 13, 1999

Confirmation No.: 5130

Title: PROCESS FOR SAWING
SUBSTRATE STRIP

Attorney Docket: SUJA3001/WKP

Customer No.: 23364

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE

MAIL STOP APPEAL BRIEF-PATENTS

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

In response to the Notification of Non-Compliance mailed January 12, 2004, the Appeal Brief filed on October 28, 2003 is being resubmitted herewith to place same in full compliance with the Notice.

The Examiner indicated that the Appeal Brief, as originally filed, did not contain a concise explanation of the claimed invention with reference to the specification by page and line number and to the drawing. In the appended refiled Appeal Brief, Applicants have included an Appendix of Specification, which is the pending specification that incorporates all of the previously entered amendments to the specification. The refiled Appeal Brief specifically refers to the page and line numbers of the Appendix of Specification. Withdrawal of this objection is respectfully requested.

The Examiner has indicated that a single ground of rejection has been applied to two or more claims in the application, wherein the Brief as originally filed includes the statement required by 35 C.F.R. § 1.192(c)(7) that one or more claims do not stand or

fall together, yet does not present arguments in support thereof in the argument section of the Brief. The refiled Appeal Brief more distinctly argues the merits of the dependent claims, in particular claims 10 and 11.

The Examiner has indicated that the status of amendment is not accurate, as stated in the original Appeal Brief, because the interview on July 17, 2003 did not result in an agreement that the proposed amendment of claim 7 is "allowed and will be entered". The originally filed Appeal Brief states:

In an Advisory Action dated July 15, 2003, the Examiner indicated that the amendment would be entered for purposes of this appeal. Thereafter, an interview with the Examiner and Applicants' Attorney took place on July 17, 2003, and on July 21, 2003 Applicant submitted proposed amendments to independent claim 7 in accord with the earlier interview for the purpose of getting the application allowed, but the proposed amendments to claim 7 was not entered by the Examiner.

Applicants submitted proposed amendments on July 21, 2003 for the purpose of getting the application allowed, in other words, with the belief that such proposed amendments would be sufficient to place the application in condition for allowance. No agreement resulted in the interview of July 17, 2003 that the proposed amendment of claim 7 would be allowed.

The Examiner further indicated that there is no record of any interview on July 21, 2003. The quoted statement above specifically indicates that on July 21, 2003 Applicants submitted proposed amendments to independent claim 7 in accord with the earlier interview, and the "earlier interview" refers to the interview of July 17, 2003. There is no interview held on July 21, 2003 and no substantive agreement was reached in the interview of July 21, 2003. The refiled Appeal Brief addresses and clarifies the issues raised by the Examiner.

Applicants thank the Examiner for the comments made in the Notification of Non-Compliance. Accordingly, the refiled Appeal Brief is believed to fully address the issues

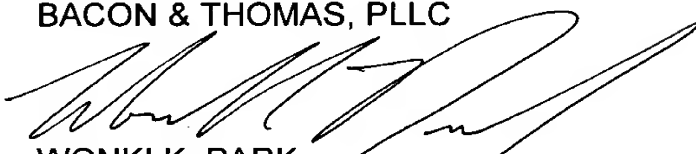
Serial No.: 09/394,918
Group Art Unit: 3724
Examiner: Omar FLORES-SANCHEZ

raised by the Examiner.

In addition, the refiled Appeal Brief includes Appendices for the Abstract, Drawings and a Dictionary Definition of "juxtaposed", for the convenience of the reader.

In the event there are any outstanding matters remaining in the present application which can be resolved by a telephone call or facsimile communication to Applicants' Attorney, the Examiner is invited to contact the undersigned by telephone or facsimile at the numbers provided below.

Respectfully submitted,
BACON & THOMAS, PLLC



WONKI K. PARK
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Date: February 12, 2004

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